

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed August 18, 2009. At the time of the Final Office Action, Claims 9-13 and 15-16 were pending in this Application. Claims 9-13 and 15-16 were rejected. Claim 9 is herein amended. Claims 1-8 and 14 were previously cancelled without prejudice or disclaimer. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. §103

Claims 9-13 and 15-16 were rejected under 35 U.S.C. §103(a) as being unpatentable over PCT Publication No. WO 98/30053 filed by Tomas J. Holmstrom et al. ("Holmstrom") in view of U.S. Patent No. 6,009,338 issued to Yuji Iwata et al. ("Iwata"). Applicant respectfully traverses and submits the cited art combinations, even if proper, which Applicant does not concede, does not render the claimed embodiment of the invention obvious.

In order to establish a *prima facie* case of obviousness, the references cited by the Examiner must disclose all claimed limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974). Even if each limitation is disclosed in a combination of references, however, a claim composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR Int'l. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007). Rather, the Examiner must identify an apparent reason to combine the known elements in the fashion claimed. *Id.* "Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *Id.*, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006). Finally, the reason must be free of the distortion caused by hindsight bias and may not rely on *ex post* reasoning. *KSR*, 127 S.Ct. at 1742. In addition, evidence that such a combination was uniquely challenging or difficult tends to show that a claim was not obvious. *Leapfrog Enterprises, Inc. v. Fisher-Price, Inc. and Mattel, Inc.*, 485 F.3d 1157, 1162 (Fed. Cir. 2007), citing *KSR*, 127 S.Ct. at 1741.

Holmstrom and *Iwata*, alone or in combination, fail to teach all limitations of Applicant's claims, and thus cannot render such claims obvious. For example, Claim 9 as amended recites:

at least one electronic telephone directory ...

at least one database stored in the nonvolatile memory and, each of the at least one database being respectively assigned to precisely one of the at least one electronic telephone directory;

...

wherein when an entry in a particular telephone directory is accessed, the mobile phone automatically performs a test to determine whether a database corresponding to the particular telephone directory is stored in the nonvolatile memory.

The highlighted limitation is supported, for example, at paragraph 3 of the "Summary of the Invention" section of Applicant's specification:

When an entry in a telephone directory is accessed, a test is first automatically carried out to determine whether there is a database for this telephone directory. If this is the case, the additional information present in the database relating to the telephone number of the above entry can be made accessible as a key . the database which is assigned to a telephone directory is preferably in the form of an expansion telephone directory. A number of expansion telephone directories also can be assigned to each telephone directory.

Holmstrom and *Iwata* do not teach this limitation. The Examiner acknowledges that *Holmstrom* does not teach databases assigned to respective directories, where telephone directory entries include phone numbers and names, and corresponding database entries include additional information relating to the numbers and names of the directory entries. (Final Office Action, page 3). The Examiner, however, alleges that *Iwata* teaches these limitations:

... Iwata does teach a mobile phone (See fig. 1) comprising an electronic telephone directory wherein at least one expansion telephone directory entry (at least one database) having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry (e.g. home address, office address, company's name, a home fax number, office fax number) being respectively assigned to precisely each entry of a telephone directory (e.g., MATSUURA JIRO); therefore, the

combination of Holmstrom & Iwata would arrive to the claimed subject matters recited in claim 9 (See above rejection for details). For that reason, the rejections are proper and maintained.

(Final Office Action, pages 4-5)

Applicant has previously argued that the cited passages of *Iwata* does not teach a separate telephone directory and corresponding database, but instead teaches a single "ADDRESS BOOK" that includes all of the data that the Examiner attempts to equate with telephone directory entries and corresponding database entries. In *Iwata*'s system, all of the data for each entry (e.g., MATSUURA JIRO entry) is stored together in the ADDRESS BOOK, rather than in a telephone directory storing some data and a corresponding database storing addition data, as recited in Applicant's claims. Thus, *Iwata* actually teaches away from Applicant's invention.

The fact that *Iwata* may store data similar to that which may be stored in a database entry and corresponding telephone directory is not sufficient. The claimed invention relates not to the type of data being stored, but to the manner in which the data is stored and linked together -- specifically, in telephone directory entries including a relatively small amount of data, and corresponding database entries including additional related data. This allows telephone directory entries that may be limited in size to be conveniently linked to a database entries that may have a variable size for data that may not be stored in the telephone directory (due to size or field limitations). As discussed above, *Iwata* stores all of this data together in a single ADDRESS BOOK, and thus cannot be related to the claimed invention.

However, despite these arguments, the Examiner has maintained his position stated above. Thus, although Applicant respectfully disagrees with the Examiner, Applicant has amended the claims to further distinguish the claims from *Iwata*. In particular, Applicant has included the limitation "*wherein when an entry in a particular telephone directory is accessed, the mobile phone automatically performs a test to determine whether a database corresponding to the particular telephone directory is stored in the nonvolatile memory.*" *Iwata* teaches away from this limitation. As discussed above, *Iwata* stores all of the data for a particular entry (e.g., MATSUURA JIRO entry) together in the ADDRESS BOOK. Thus, when *Iwata*'s device needs to access the additional information (e.g., home address) for a

particular entry, the device simply acquires that information from the same ADDRESS BOOK as the name and number for that particular entry. Thus, there is no reason to perform any test to determine whether a database exists that corresponds to the ADDRESS BOOK. Thus, even if *Iwata* was modified as suggested by the Examiner such that the ADDRESS BOOK was divided between a “directory” portion (name and number information) and a “database” portion (additional information), with the “database” portion stored in nonvolatile memory, there would be no use for a test to determine whether the “database” portion was stored in nonvolatile memory upon accessing an entry from the “directory” portion. For starters, there is no suggestion in *Iwata* that the whole “database” portion (additional information) *may not be present* for particular ADDRESS BOOKS. Further, *Iwata* fails to teach anything that could be equated with a test as recited in Claim 9.

For at least the reasons discussed above, amended Claim 9 is allowable over the proposed *Holmstrom-Iwata* combination. Accordingly, Applicant respectfully requests reconsideration and allowance of amended Claim 9, as well as all claims that depend from Claim 9.

CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant respectfully submits a Petition for a Two-Month Extension of Time. The Commissioner is authorized to charge the fee of \$490 required to Deposit Account 50-4871 in order to effectuate this filing.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any other fees necessary or credit any overpayment to Deposit Account No. 50-4871 of King & Spalding L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.457.2030.

Respectfully submitted,
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Date: 1/19/2010

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